

REMARKS

The undersigned thanks Examiner Cooney for allowing claims 41-56 and 92 and withdrawing the anticipation rejection of the prior Action.

The objection of claim 108 is moot because claims 108 has been canceled without prejudice or disclaimer.

Claims 96-134 and 160 have been rejected as being obvious over US 4,451,582 (Chesler) in view of EP 0422460A2 (Grimmer), US 4,518,557 (Wecker) and US 5,906,999 (Valoppi). This rejection is respectfully traversed.

In column 4, lines 43-60, Chesler discloses the use of comminuted foam scraps in flexible polyurethane foam. However, Chesler's disclosure is strictly limited to the use of comminuted foam scraps of flexible polyurethane, not polymer sheet or paper, which even the Examiner has acknowledged. To fill this gap in Chesler, the Examiner has argued that because the other references allegedly teach polymer sheeting, it would have been obvious to add the polymer sheeting of the other references in the flexible polyurethane foam of Chesler. This argument begs the real question: Why would anybody have been motivated to select the polymer sheeting of the other references, made a contaminant powder of the polymer sheeting and combine the contaminant powder in the flexible polyurethane foam of Chesler? Please keep in mind that Chesler specifically only suggests that "[a]ny flexible polyurethane foam scrap material may be included in the reaction in making new polyurethane foam following the process of the invention." Chesler, column 4, lines 53-56. There is no suggestion in Chesler that one should use any other scrap other than flexible polyurethane foam. There is no suggestion in the other references to use polymer sheeting as scraps in flexible polyurethane foam. There is no suggestion in any cited reference to make a contaminant powder of polymer sheet. So, where is

the suggestion to combine Chesler and the other references such that one would have arrived at the present invention? There is none.

The Examiner's stated motivation for persons of ordinary skill in this art to combine Chesler with the other references is "for the purpose of obtaining a processable powdered article in order to arrive at the products of the applicants' claims with the expectation of success in the absence of a showing of new or unexpected results." See page 4, lines 2-5.

The Examiner's alleged motivation that persons of ordinary skill would have been motivated to combine the cited references "for the purpose of obtaining a processable powdered article in order to arrive at the products of the applicants' claims" is such a general motivation that it does not respond to the evidentiary burden which the Examiner must satisfy to make out a *prima facie* case of obviousness. Such a motivation that that one would have been motivated to combine the cited references "for the purpose of obtaining a processable powdered article" is so broad that it would apply to *all inventions directed to a powder*. Thus, such a motivation does not answer the central question of why, out of all the references disclosing recycling of flexible polyurethane foam scrap, which is the subject of Chesler's patent—and there must be hundreds of such references—would a person of ordinary skill in the art choose Chesler as the disclosure to look to, and furthermore add a contaminant powder of polymer sheeting as a contaminant? The answer is apparent: Without Appellant's disclosure and claims as a roadmap, *no* person of ordinary skill in this art would have chosen Chesler's foam and added a polymer sheeting, particularly when Chester only teaches that "[a]ny *flexible polyurethane foam* scrap material may be included in the reaction in making new polyurethane foam following the process of the invention." Chesler, column 4, lines 53-56; emphasis added. The polymer sheeting of Grimmer, Wecker and Valoppi are *not* made of flexible polyurethane

foam. The combination of Chesler with Grimmer, Wecker and Valoppi is classic, impermissible hindsight as is evidenced by the Examiner statement that one would have combined the cited references “for the purpose of obtaining a processable powdered article *in order to arrive at the products of the applicants’ claims ...* .” See page 4, lines 2-5; emphasis added. Clearly, the Examiner has used Applicants claims as a roadmap to combine the cited references.

Furthermore, the Examiner has provided no logical or technical reasoning *why* one would add a contaminant powder of polymer sheeting as a contaminant in flexible polyurethane foam. Yes, the logical thing to do would have been what Chesler does, i.e., to add comminuted flexible polyurethane foam scrap to the liquid reaction mixture that would be used to form a similar flexible polyurethane foam. However, there is *no* logical or technical reasoning why one would add a contaminant powder of polymer sheeting contaminant in flexible polyurethane foam. This invention is the unexpected outcome of a process which has now been patented on the parent application to form the claimed “powder having a maximum particle size of 2 mm, comprising a contaminant powder of a contaminant and at least 5% by weight of a comminuted polyurethane foam powder, wherein the contaminant is selected from the group consisting of polymer sheeting, and paper, further wherein the comminuted polyurethane foam powder is a powder of flexible reversibly deformable foam having a majority of open cells.” Applicants respectfully submit that the patented process of the parent application was unknown prior to this invention. Without the knowledge of Applicants patented process, Applicants believe that persons of ordinary skill would neither have even hypothesized the powder of claim 96, nor would they have had any means to arrive at the claimed powder.

The Examiner’s selected motivation (quoted above) is so general in the context of the relevant art that it constitutes no more than the reference to a general level of skill in the art

found deficient in *In re Lee*, 277 F.3d, 1338, 61 USPQ2d 1430 (Fed. Cir. 2002). As emphasized by the court in *In re Lee*, 61 USPQ2d at 1433, the Examiner **must** present specific evidence of motivation, not the generalized evidence relied on in the Action:

When patentability turns on the question of obviousness, the search for and analysis of the prior art includes evidence relevant to the finding of whether there is a teaching, motivation, or suggestion to select and combine the references relied on as evidence of obviousness. See, e.g., *McGinley v. Franklin Sports, Inc.*, 262 F.3d 1339, 1351-52, 60 USPQ2d 1001, 1008 (Fed. Cir. 2001) (“the central question is whether there is reason to combine [the] references,” a question of fact drawing on the *Graham* factors).

The burden imposed by *Lee* is not an impossible burden, as explained by the court in *In re Thrift*, 298 F.3d 1357, 1364-65, 63 USPQ2d 2002 (Fed. Cir. 2002), with respect to the references relied on by the Board in that case:

In the present case, the reasoning articulated by the Board is exactly the type of reasoning required by *In re Lee*. Both the examiner and the Board clearly identified a motivation to combine the references, stating that the skilled artisan would have “found it obvious to incorporate the speech input and speech recognition techniques taught by Schmandt into the expert system of Stefanopoulos in order to reduce the need for less user friendly manual keyboard and mouse click inputs.” Decision on Appeal at 5; accord Aug. 7, 1996 Office Action at 3. The motivation to combine the references is present in the text of each reference. The Schmandt reference itself verifies this motivation, stating that “allowing users to remain focused on the screen and keyboard, instead of fumbling for the mouse, would be beneficial in a workstation environment.” Schmandt at 51. Stefanopoulos itself, while not expressly disclosing the use of speech recognition, sets forth the motivation to combine the references, stating that “there are alternative means to select the buttons, including . . . voice-activated transfer means, which may be readily adapted for use with the present invention by those skilled in the art.” ’237 patent, col. 4, ll. 34-38.

The reliance in the Action on the fact that it would have been obvious to one of ordinary skill in the art at the time of invention to combine Chesler with the other references “for the

purpose of obtaining a processable powdered article in order to arrive at the products of the applicants' claims" (citation omitted) to arrive at the claimed powder comes nowhere close to the analysis required by *Lee* and approved in *Thrift*.

Based on *Lee* and *Thrift*, the appropriate question to ask again at this point in the analysis is: why, based on Chesler, would a person of ordinary skill in the art have had *any* reason to look for a contaminant powder of polymer sheeting as a contaminant in the reaction mixture of the flexible polyurethane foam of Chesler? There is only one reasonable answer: impermissible hindsight reliance on Appellant's disclosure and claims as a roadmap to choose Chesler and other cited references.¹ This failure to present evidence of motivation requires that the rejection be withdrawn.

As a closing comment, Applicants respectfully submit that Chesler is directed to recycling of flexible polyurethane foam scrap. The disclosure relating to a powder in Chesler relates to a "comminuted, flexible polyurethane foam scrap" in column 4, lines 45 and 46. There is simply *no* teaching or suggestion from what Chesler discloses to the claimed powder having a maximum particle size of 2 mm, comprising a contaminant powder of a contaminant and at least 5% by weight of a comminuted polyurethane foam powder, wherein the contaminant is selected from the group consisting of polymer sheeting, and paper, further wherein the comminuted polyurethane foam powder is a powder of flexible reversibly deformable foam having a majority of open cells, as recited in claim 96. Combining Chesler with the secondary references to arrive

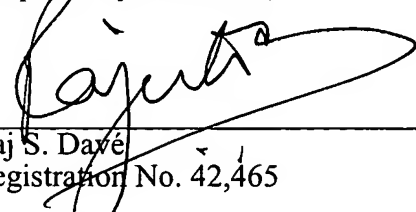
¹ Applicants recognize that an Examiner cannot search prior art to use in examining a patent application without reading the application and its claims first. That much "hindsight" is permissible and expected in the examination process. However, that is as far as hindsight in the examination process can go. Once the Examiner finds prior art that appears to be relevant based on the limited amount of hindsight that is permissible, *Lee* and *Thrift* require the Examiner to point to *evidence* within the prior art references themselves as to why persons of ordinary skill in the art would have been motivated to combine the disclosures so as to arrive at the claimed invention. Applicants' position rests on the Examiner's failure to produce and rely on objective evidence of motivation in the prior art itself.

at the claimed powder is even more further removed from the teachings of Chesler.

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Respectfully submitted,



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